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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,747	08/28/2003	Cynthia L. Ebner	D-43641-01	5716
7590 Howard Troffkin 7808 Ivey Mount Terrace Potomac, MD 20854				
EXAMINER				
HAIDER, SAIRA BANO				
ART UNIT		PAPER NUMBER		
1796				
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02/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/649,747

Applicant(s)

EBNER ET AL.

Examiner

SAIRA HAIDER

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 6, 14 and 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-5, 7-13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ito et al. (US 6,458,437), Chang et al. (US 4,485,228), and Taylor (US 4,038,228).
3. Ito discloses a heat-shrinkable polyester film comprising a polyester elastomer which is a polyester block copolymer (abstract; 211-15; 3:36-47). Wherein the polyester film is suitable as labels on PET bottles (1:4-13). The polyester block copolymer comprises high melting point crystalline polyester segments (hard segments) and low melting point soft polymer segments (soft segments). The hard segments are formed of dicarboxylic acid residues (such as terephthalic acid) and diol residues (such as ethylene glycol) (3:48-4:5). The soft segments is formed of polymers of cyclic esters (such as poly-ε-caprolactone). The soft segments have melting points of 80°C or less and have a molecular weight in the range of 400-8000 (4:6-27). The soft segment is 1-90 wt% of the polyester block copolymer, accordingly the hard segment is 10-99 wt% of the polyester block copolymer (4:15-18).
4. Ito fails to disclose the claimed alicyclic non-aromatic compound (the (a) unit for the prepolymer P^A). Hence attention is directed towards the Chang reference which explicitly discloses that terephthalic acid and tetrahydrophthalic acid (or its anhydride) are considered functional equivalents (4:49-64). Therefore, because the these compounds were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute tetrahydrophthalic acid (or its anhydride) for the terephthalic acid of Ito.

5. The combination of Ito and Chang above fail to disclose the inclusion of a transition metal salt in the film composition, as claimed. Thus attention is directed towards the Taylor reference.

Taylor discloses the formation of transition metal salt compounds which improves the degradation of polymers (1:60-2:5; 3:4-13). Accordingly, it would have been obvious to one of ordinary skill in the art to include a transition metal salt in the film taught by Ito and Chang in order to form a film which is capable of non-photochemical degradation of the polymer post consumer consumption.

6. In reference to the claimed glass transition temperature of the prepolymer (P^A), it is noted that since the prior art teaches the identical chemical structures, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The burden shifts to the applicant to show an unobvious difference. Note, that because the reference does not expressly teach or address the properties of the claimed invention, does not mean that the properties are not inherently disclosed. Teaching the same compound(s) inherently discloses the corresponding properties. The references cannot possibly teach or address all of the properties, but implicitly all of the properties are present.

7. In reference to the newly added terminology "consisting essentially of," as per MPEP § 2111.03, the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).

However, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., *PPC*, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has

the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lejarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

8. Applicant has not fulfilled the above requirements regarding utilization of the transitional phrase "consisting essentially of," hence the transitional phrase is construed as equivalent to "comprising." Therefore, the rejection is rendered valid.

Response to Arguments

9. Applicant has essentially argued that the terminology "consisting essentially of" eliminates the polyester elastomer present in the Ito invention; however, in the absence of any showings that the introduction of additional components would materially change the characteristics of applicant's invention, the rejection has been maintained.

10. In response to applicant's argument that the invention of Ito is different than the claimed invention because Ito is not drawn to oxygen scavenging, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Since the prior art structure is capable of performing the intended use, then it meets the claim.

11. Applicant has argued the presence of unexpected results via the inclusion of the (a) unit in prepolymer P^A; however, the examiner is unable to locate any such factual support in the Specification.

12. Applicant has argued that the Chang reference is unrelated and thus cannot be combined with the Ito reference. In response, the Chang reference has been relied on to teach that well known polycarboxylic acid components include terephthalic acid and tetrahydrophthalic acid (or its anhydride), wherein these two both have dicarboxylic residues and thus are considered functional

equivalent. The Chang reference is not relied on in any other way, thus the arguments regarding the thermosetting and urethane are not pertinent.

13. In response to applicant's argument that the motivation to include the transition metal salt of Taylor is different than applicants, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAIRA HAIDER whose telephone number is (571)272-3553. The examiner can normally be reached on Monday-Friday from 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

Saira Haider
Examiner
Art Unit 1796